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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/423,974	01/05/2000	NADIA TERREN	05725.0490	7391

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EXAMINER

BERMAN, ALYSIA

ART UNIT	PAPER NUMBER
1617	11

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/423,974

Applicant(s)

TERREN ET AL.

Examiner

Alycia Berman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 February 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 75-80,82-94 and 96-108 is/are pending in the application.
 - 4a) Of the above claim(s) 108 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 75-80,82-94 and 96-107 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Receipt is acknowledged of the amendment and information disclosure statement filed February 19, 2002. Claims 47-74, 81 and 95 have been canceled. Claims 75, 82, 91, 96 and 104 have been amended. Claims 107 and 108 have been added. Claims 75-80, 82-94 and 96-108 are pending.

Election/Restrictions

2. Newly submitted claim 108 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims to a method of including a solid water-in-oil emulsion in a cosmetic composition were not originally presented.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 108 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 87-89, 94 and 107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 87-89 are indefinite because it is unclear if the claims require a volatile isoparaffin in addition to or in place of the silicone oil of the independent claim.

Amendment of the claim to read, "the fatty phase further comprises," would overcome this rejection.

6. Claim 94 is indefinite because it broadens the independent claim, which is limited to polyethylene wax, hydrogenated jojoba oil and/or ozokerite.

7. Claim 107 is vague and indefinite because it is unclear what amount of the emulsion is effective to provide transfer resistance to a cosmetic composition. Neither the specification nor the claims provides any guidance to the effective amount of the emulsion in cosmetic compositions. The metes and bounds of the claim cannot be determined.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The Examiner would like to thank Applicant for pointing out the mistake in the 35 U.S.C. 102(b) rejection. The Examiner cited the incorrect EP document 374 332 A1.

The correct reference cited should have been EP 595 683 A1 as recognized by Applicant.

10. The 35 U.S.C. 102(b) rejection of the claims over EP 595 683 A1 (US 5,851,539) is withdrawn in view of Applicant's remarks. The reference does not teach the capability of the wax to confer a penetration force greater than 50 grams on the emulsion as instantly claimed.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 75-80, 82-86, 90-94 and 97-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 595 683 (A1) in view of US 5,196,187 A (187).

This rejection is maintained for reasons of record in the Office Action mailed September 17, 2001, paper no. 7. With regard to new claim 107, preamble limitations are not given patentable weight over the prior art composition. See *In re Tuominen*, 213 USPQ 89, and *In re Pearson*, 181 USPQ 641. Pearson stated that a known composition cannot be patented solely on preamble use. Discovery of a new property or use of a previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to a known composition. *In re Spada* 15 USPQ 1655 and MPEP

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2112.01. The compositions of the prior art containing the same components as instantly claimed would be expected to exhibit the same properties, absent evidence to the contrary.

Further, US '539 discloses that its emulsions provide good preservation of efficacy over time, a high water-repelling property and good resistance to sweat and sebum (col. 1, lines 11-25 and col. 2, lines 16-19). It is the Examiner's position that this encompasses transfer resistance as instantly claimed.

14. Claims 75-80, 82-84, 90-94 and 96-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 595 683 in view of US 5,650,139 (139).

This rejection is maintained for reasons of record in paper no. 7.

15. Claims 75-80, 82-84, 87-94 and 97-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 595 683 A1 (683) in view of US 4,536,405 A (405).

This rejection is maintained for reasons of record in paper no. 7.

Unexpected Results

16. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

In the instant case, the data presented in the table at page 20 of the instant specification does not compare the instant invention to the closest prior art. Further, it is specific to emulsions containing 6.3 wt.% of either hydrogenated jojoba oil or polyethylene wax and, thus, is not commensurate in scope with the independent claims.

Response to Arguments

17. Applicant's arguments filed February 19, 2002 have been fully considered but they are not persuasive.

18. Applicant argues that the references fail to teach or suggest the use of a wax capable of conferring a penetration force on the emulsion of greater than or equal to 50 grams. This argument is not persuasive because, although the references do not explicitly teach or suggest this property, they do disclose Applicant's preferred waxes. Applicant discloses that the preferred waxes for use in the instantly claimed compositions are polyethylene wax and hydrogenated jojoba oil either alone or in combination with each other. Applicant further discloses in the table at page 20 of the instant specification that the each of the preferred waxes alone confers a penetration force on the emulsions of greater than 50 grams. Reference to the penetration force of the emulsion obtained from Example 2 of the instant application could not be found.

US '539 discloses polyethylene wax and hydrogenated oils that are solid at 25° C. One skilled in the art would expect the addition of the same waxes as preferred by Applicant to the emulsions to provide the same properties. Therefore, absent evidence of unexpected results over the prior art, the limitation regarding the capability of a wax to confer a penetration force on the emulsion of greater than 50 grams is not given

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patentable weight. Applicant has not provided data showing unexpected results over the cited prior art.

19. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The prior art of record teaches all of the components of the instant claims in cosmetic compositions.

20. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the teachings of the references is for their known cosmetic properties as stated in paper no. 7.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alyria Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.



Alycia Berman
Patent Examiner
April 23, 2002

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